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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,038	10/15/2001	Timothy W. Dygert	1617.1001CIP	2537
20306	7590	01/09/2004	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF 300 SOUTH WACKER DRIVE SUITE 3200 CHICAGO, IL 60606			ALI, MOHAMMAD	
		ART UNIT		PAPER NUMBER
		2177		S
DATE MAILED: 01/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/976,038	DYGERT ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
Mohammad Ali	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15 October 2001.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-5 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-5 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.  
4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This communication is responsive to the application filed on October 15, 2001.
2. The application has been examined. Claims 1-5 are pending in this Office Action.

#### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(e), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

4. The references cited in the IDS, PTO-1449, Paper No. 4, have been considered.

#### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,304,523 B1.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because they are substantially similar in scope and they use the same limitations, using varying terminology. Please see explanation below:

The following table shows the claims in 09/976,038 that are rejected by corresponding claim of 6,304,523.

**Claims Comparison Table**

	09/976,038	6,304,523 B1
Claim	1	1

Certain limitations including 'dial-tone multifrequency signals to communicate' found in claim 1 of US Patent 6,304,523 B1 are not found in claim 1 of this instant application. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to exclude the terms 'dial-tone multifrequency signals to communicate' because the remaining elements would have performed the same function as before. "Omission of element and its function and its function in combination is obvious expedient if the remaining elements perform the same function as before" See *In re Karlson (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.*

This is a obviousness-type double patenting rejection.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl J. Yankowski ('Yankowski' hereinafter), US Patent 5,751,672 in view of Downs et al. ('Downs' hereinafter), US Patent 6,327,233 B1.

With respectfully claim 1,

Yankowski discloses an apparatus for playback of recordings and communication with a remote database to obtain information about the recordings and provide at least textual data for a display unit (see col. 2, lines 26-33, Fig. 1), comprising:

Yankowski teaches a recorded signal output device to reproduce a recorded signal from a recording (see col. 4, lines 26-33);

Yankowski teaches a video output to provide the textual data to the display unit (see col. 13, lines 3-6 et seq);

Yankowski teaches a memory to store a textual recording name of the recording and indicating data, obtained from said recorded signal output device, that can be used for identification of the recording (see col. 4, lines 5-24);

Yankowski teaches a communication device, occasionally in communication with the remote database, to obtain the textual recording name by sending the indicating data to the remote database (see col. 15-25 et seq); and

Yankowski teaches a controller, coupled to said recorded signal output device, said video output, said memory and said communication device, to control said apparatus to play back the recording regardless of whether said communication device is in communication with the remote database, to repeatedly try to establish communication with the remote database until communication is established (see col. 3, lines 46-56 et seq), to query the remote database using the indicating data when communication is established and to supply the textual recording name of the recording from the remote database to said memory (see col. 4, lines 5-24).

Yankowski does not explicitly indicate the claimed 'textual data'.

Downs discloses the claimed textual data (CD-TEXT formatting uses designate bits to store textual information, see col. 2, lines 46-48, Fig. 2 et seq).

It would been obvious to one ordinary skill in the data processing art, at the time of the present invention, to combined the teachings of the cited references because the textual data of Downs teachings would have allowed Yankowski's system provides to play CD in the remote system, as suggested by Downs at col. 1, lines 45-47. Textual data as taught by Downs improves remote system to play CD or other device in the network (see col. 2, lines 3-16, Fig. 1).

As to claim 2,

Yankowski teaches wherein the communication device is a cellular two-way network interface (see col. 8, lines 60-65 et seq).

As to claim 3,

Yankowski teaches wherein the communication device is an 802.11a network interface and said apparatus is mounted in an automobile (see col. 6, lines 64 to col. 7, lines 3 et seq).

As to claim 4,

Yankowski teaches wherein the communication device is an 802.11b network interface and said apparatus is mounted in an automobile (see col. 6, lines 55 to col. 7, lines 3).

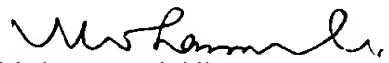
As to claim 5,

Yankowski teaches wherein the communication device is a Bluetooth network interface and said apparatus is portable (see col. 6, lines 55 to col. 7, lines 3, Fig. 1)

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (703) 605-4356. The examiner can normally be reached on Monday to Thursday from 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790 or Customer Service (703) 306-5631. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for any communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

  
Mohammad Ali

Patent Examiner

AU 2177

MA

January 7, 2004